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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/757,346

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Heinrich Kladders

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3492

28501

7590

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EXAMINER

MATTER, KRISTIN CLARETTE

ART UNIT

PAPER NUMBER

3771

MAIL DATE

DELIVERY MODE

03/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/757,346

Applicant(s)

KLADDERS ET AL.

Examiner

KRISTEN C. MATTER

Art Unit

3771

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-10.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Justine R Yu/
Supervisory Patent Examiner, Art Unit 3771

/Kristen C. Matter/
Examiner, Art Unit 3771

Continuation of 11, does NOT place the application in condition for allowance because: In response to applicant's argument that the examiner's conclusion that the '010 patent teaches that the indentations and raised areas can be different shapes is improper, examiner respectfully points out that the teaching that the "path configuration" can be different shapes and the size of the indentations can be different sizes was pointed out in support of the conclusion that by having different path shapes and sizes, there will be different contact surface area and thus, not all embodiments of the '010 patent in fact are the "smallest possible contact area" as argued by the applicant previously because different combinations of shapes and sizes would produce different contact areas, not all of which would be equal. Examiner acknowledges that the '010 patent does not teach sloped or tapered walls. However, as discussed in all previous rejections, changing the shape of the indentations from valleys walls that are perpendicular to the surface plane to walls that are sloped/tapered is considered an obvious design consideration to one of ordinary skill in the art depending on the desired fabrication technique, and a mere change in shape without a change in function does not patentably distinguish the invention over the prior art. Sloped/tapered grooves are well known and commonly used with microtechnology fabrication techniques and therefore one of ordinary skill in the art would have found it obvious to change the shape of the grooves of the '010 patent depending on the available materials, molds, film, lasers, etching machines, etc. or so that the groove edges were less likely to break/fail. Moreover, a change in shape would not change the function of the grooves and whether the indentations had rounded bottoms or straight bottoms, the contact area would be minimized and the device would perform equally well.

In response to applicant's request for evidence of a motivation to change shape of the grooves, examiner cites *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (holding that the configuration of a claimed plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant). Examiner also points to *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007) in which predictable results (i.e., decreasing contact area) that are obtained through simple substitution of one known element (i.e., tapered grooves) for another (i.e., square grooves) was held to not patentably distinguish over the prior art.

In response to applicant's argument that the indentations provide unexpected results, examiner notes that mere conclusionary statements are not enough to establish patentability if not supported by evidence. Additionally, page 5, lines 25-30 appears to apply to indentations in general, not necessarily the sloped/tapered indentations that applicant claims as critical. Examiner also notes that even though the '010 patent may teach a shape that is less than optimal as suggested by the applicant, this does not mean that the reference teaches away from the claimed tapered shape in the instant application. Regardless of the shape of the grooves, as long as the contact area is minimized from a surface without grooves, the device would perform equally well. Applicant's statement that the grooves provide an "optimal property" are therefore not enough to patentably distinguish the invention over the prior art.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Here, the change in shape would have been both possible and obvious to one of ordinary skill in the art at the time the invention was made as discussed in great detail previously.